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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MORGAN, LEWIS & BOCKIUS, LLP.
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306

EXAMINER

LE, MIRANDA

ART UNIT PAPER NUMBER

2167

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,348

Applicant(s)

KOKKONEN ET AL.

Examiner

Miranda Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to Amendment filed 10/14/2004.
2. Claims 1-48 are pending in this application. Claims 1, 7, 8, 14, 15, 21, 22, 26, 29, 34-36, are independent claims. In the Amendment, claims 1, 2, 7-9, 14-16, 21-22, 25-26, 28-29, 31, 34-36 have been amended, no claims have been added, or cancelled. This action is made Final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 5-9, 12-16, 19-21, 37-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Bailey et al. (US Patent No. 6,785,671 B1).

Bailey anticipated independent claims 1, 7, 8, 14, 15, 21, 22, 26, 29, 34-36 by the following:

As to claims 1, 8, 15, Bailey teaches “a method of generating directed content...receiving a set of lists from a plurality of remote web services that are adapted to

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receive submissions of at least one search term and perform a search for the search term submitted, each list in said set of lists being associated with, and maintained by, the respective web service, each list in said set of lists including search terms submitted to said respective web service that were used by said respective web service to perform searches” at col. 2, line 30 to col. 3, line 23;

“distilling said set of lists into a frequency database, the database storing search frequency information indicating, for respective search terms, a frequency with which each of the search terms were submitted to one or more of the plurality of remote web services for searching by the respective remote web service” at col. 6, lines 27-50;

“obtaining a query” at col. 6, line 51 to col. 7, line 20, col. 10, line 60 to col. 11, line 51;

“searching the frequency database for matches between said query and search terms in the database, the matches indicating that the obtained query was submitted as a search term to one or more of the plurality of remote web services” at col. 6, line 51 to col. 7, line 20;

“selecting the matches having highest associated frequencies, each selected match indicating a respective selected remote web service to which said query was submitted as a search term” at col. 24, lines 7-31, col. 21, line 49 to col. 22, line 19;

“generating directed content based on one or more of the selected web services so that the directed content is generated based on the remote web services” at col. 8, lines 4-49, col. 10, line 60 to col. 11, line 51.

As to claims 7, 14, 21, Bailey teaches “a method of generating directed content, the method comprising: receiving a plurality of lists from a plurality of remote web services that are

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adapted to receive submissions of at least one search term and perform a search for the search term submitted, each list in said plurality of lists being associated with, and maintained by, the respective web service, each list in said plurality of lists including the search terms submitted to said respective web service that were used by said respective web service to perform searches” at col. 2, line 30 to col. 3, line 23;

“distilling said plurality of lists into a frequency sorted list, the frequency sorted list including a plurality of entries, each entry having a search term and a number of times said search was submitted to a respective web service for searching by the respective remote web service” at col. 6, lines 27-50;

“obtaining a query” at col. 6, line 51 to col. 7, line 20, col. 10, line 60 to col. 11, line 51;

“searching the frequency sorted list for matches between said query and a search term in the frequency sorted list, the matches indicating that the query was submitted as a search term to the respective remote web service” at col. 6, line 51 to col. 7, line 20;

“selecting the matches having highest associated frequencies, each selected match indicting a respective selected remote web service of the web services to which said query was submitted as a search term” at col. 24, lines 7-31, col. 21, line 49 to col. 22, line 19;

“generating directed content based on one or more of the respective selected remote web services so that the directed content is generated based on the remote web services having the highest associated frequencies for the obtained query” at col. 8, lines 4-49, col. 10, line 60 to col. 11, line 51.

As to claims 2, 9, 16, Bailey teaches “directed content is a link to a web service that was selected during said searching step to which said query was submitted as a search term with high associated frequency” at col. 10, line 60 to col. 11, line 51, col. 16, line 56 to col. 17, line 28.

As to claims 5, 12, 19, Bailey teaches “a match having highest associated frequency is determined by a rank of a search term, which matches said query, in a list associated with a web service in said plurality of web services” at col. 15, line 45 to col. 16, line 44.

As to claims 6, 13, 20, Bailey teaches “a match having highest associated frequency is determined by a score that is a function of (i) a rank of a search term, which matches said query, in a list associated with a web service in said plurality of web services and (ii) the logarithm of the frequency of said search term in the list” at col. 15, line 45 to col. 16, line 44.

As to claims 37-42, Bailey teaches “each remote web service in said plurality of web services is a search engine” see Fig. 1.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 3-4, 10-11, 17-18, 22-23, 25-31, 34-36 rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. (US Patent No. 6,785,671 B1), in view of Ryan et al. (US Patent No. 6,421,675 B1).

As to claims 22, 26, 29, Bailey teaches “a method of generating a directed advertisement, the method comprising: obtaining a query” at col. 4, lines 29-48;

“searching a web resource for a match between said query and an element of said web resource” at col. 4, lines 29-48;

“selecting a remote web service based on said element of said web resource, said remote web service being adapted to receive submissions of at least one search term and perform a search for the search term submitted” at col. 4, line 29 to col. 5, line 2;

“routing said query to an instance of said selected web service” at col. 7, lines 52-58;

“searching the selected remote web service for the query” at col. 5, line 46 to col. 6, line 2;

“collecting data generated by said selected remote web service in response to said query” at col. 6, lines 3-50.

Bailey does not explicitly teach “generating said directed advertisement, said directed advertisement including a portion of said data generated in response to the query within said advertisement”. However, Ryan teaches this limitation as seen in Fig. 2.

It would have been obvious to one ordinary skilled in the art at the time of the invention was made to combine the teachings of Bailey with the teaching of Ryan to include “generating said directed advertisement, said directed advertisement including a portion of said data generated in response to the query within said advertisement” because it would allow users to efficiently and practically obtain relevant information by the most commonly used search engine.

As to claims 34, 35, 36, Bailey teaches “a method of generating a directed advertisement, the method comprising: obtaining a query” at col. 4, lines 29-48;

“selecting a remote web service based on said query, said remote web service being adapted to receive submissions of at least one search term and perform a search for the search term submitted” at col. 4, line 29 to col. 5, line 2;

“routing said query to an instance of said selected remote web service” at col. 7, lines 52-58;

“searching the selected remote web service for the query” at col. 5, line 46 to col. 6, line 2;

“collecting data generated by said selected remote web service in response to said query” at col. 6, lines 3-50.

Bailey does not explicitly teach “generating said directed advertisement, said directed advertisement including a portion of said data generated in response to the query within said advertisement”. However, Ryan teaches this limitation as seen in Fig. 2.

It would have been obvious to one ordinary skilled in the art at the time of the invention was made to combine the teachings of Bailey with the teaching of Ryan to include “generating

said directed advertisement, said directed advertisement including a portion of said data generated in response to the query within said advertisement” because it would allow users to efficiently and practically obtain relevant information by the most commonly used search engine.

As to claims 3, 10, 17, Bailey does not specifically teach “identifying a category that corresponds to a selected web service, and said directed content including an advertisement that corresponds to said category”. However, Ryan teaches this limitation at col. 11, lines 42-67, Fig. 2.

It would have been obvious to one ordinary skilled in the art at the time of the invention was made to combine the teachings of Bailey with the teaching of Ryan to include “identifying a category that corresponds to a selected web service, and said directed content including an advertisement that corresponds to said category” because it would allow users to efficiently and practically obtain relevant information by the most commonly used search engine.

As to claims 4, 11, 18, Bailey does not expressly teach the following limitations. However, Ryan teaches “routing said query to an instance of a selected remote web service” at col. 21, lines 14-49;

“collecting data generated by said selected remote web service in response to said query” at col. 23, lines 33-58;

“wherein said advertisement includes a portion of said response” see Fig. 2.

It would have been obvious to one ordinary skilled in the art at the time of the invention was made to combine the teachings of Bailey with the teaching of Ryan to include all the above

claimed limitations because it would allow users to efficiently and practically obtain relevant information by the most commonly used search engine.

As to claims 23, 27, 30, Bailey teaches “element of said web resource is a category” at col. 5, lines 11-44.

Ryan teaches this limitation at col. 11, lines 42-56.

As to claims 25, 28, 31, Bailey teaches “said web resource is a frequency database, the database having search frequency information indicating, for respective search terms, a frequency with respect to each of one or more of a plurality of web services to which the respective search terms were submitted” at col. 4, lines 18-58;

“said element of said resource is an entry in the frequency database corresponding to said selected web service, said search frequency information stored in said frequency database indicating that a search for said search term has been conducted at said selected web service at a high frequency relative to other web services of said plurality of web services” at col. 4, lines 18-58.

As to claims 43-48, Bailey teaches “each remote web service in said plurality of web services is a search engine” see Fig. 1.

5. Claims 24, 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al. (US Patent No. 6,785,671 B1), in view of Ryan et al. (US Patent No. 6,421,675 B1), in

view of Chris Sherman (“Google Introduces Web Directory Using Netscape’s Open Directory Project Data”).

As to claims 24, 32, 33, Bailey, Ryan do not specifically teach “the web resource is Open Directory Project”. However, Sherman teaches this limitation on page 1-2.

It would have been obvious to one ordinary skilled in the art at the time of the invention was made to combine the teachings of Ryan with the teaching of Sherman to include “the web resource is Open Directory Project” in order to creates the most comprehensive and robust search resource for finding information and browsing the web.

Response to Arguments

6. Applicant's arguments regarding Ryan does not teach the amended claimed limitations with respect to claims 1-48 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (571) 272-4107. The fax number to this Art Unit is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miranda Le
June 23, 2004

